

REMARKS

In the final Office Action¹, the Examiner rejected claims 43, 46, 48-51, 54, and 56-58 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent Application Publication No. 2005/0278771 to Hassell et al. ("*Hassell*") in view of U.S. Patent No. 6,588,015 to Eyer et al. ("*Eyer*"); rejected claims 44 and 52 under 35 U.S.C. § 103(a) as unpatentable over *Hassell* in view of *Eyer* and further in view of U.S. Patent No. 6,807,367 to Durlach ("*Durlach*"); rejected claims 45 and 53 under 35 U.S.C. § 103(a) as unpatentable over *Hassell* in view of *Eyer* and further in view of U.S. Patent Application Publication No. 2003/0088872 to Maissel et al. ("*Maissel*"); and rejected claims 47 and 55 under 35 U.S.C. § 103(a) as unpatentable over *Hassell* in view of *Eyer* and further in view of U.S. Patent No. 6,323,911 to Schein et al. ("*Schein*").

By this Amendment, Applicants amend claims 43-45 and 51 and add new claim 59.

I. The Rejection of Claims 43, 46, 48-51, 54, and 56-58 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 43, 46, 48-51, 54, and 56-58 as allegedly unpatentable over *Hassell* in view of *Eyer*.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. See M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007). Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *id.* "A

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” M.P.E.P. § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. M.P.E.P. § 2143.01(III), internal citation omitted. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” M.P.E.P. § 2141.02(I), internal citations omitted (emphasis in original).

“[T]he framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1996) . . . The factual inquires . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III). In this application, a *prima facie* case of obviousness has not been established because the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Independent claim 1 recites an apparatus comprising, among other things, storing means for storing a plurality of content items, input means, reproducing means for reproducing a first content item, and selection means, "wherein whether the selection means skips to the second content item or selects the position within the first content item depends on a duration of the user input."

Hassell and *Eyer*, taken alone or in combination, fails to render obvious the claimed selection means.

The Examiner concedes that *Hassell* "does not explicitly teach wherein the selection means selects the second content item or the position within the first content item based on a duration of a user input (Office Action at p. 3). *Eyer* fails to cure the deficiencies of *Hassell*.

Eyer discloses a digital broadcast system that provides interactive features such as skip forward and skip backward (*Eyer*, abstract). Users can play a current track or skip to subsequent or earlier tracks (*Eyer*, abstract). If a user wishes to play "previous portions of the current track," the user can use a REVERSE button (*Eyer*, col. 7, lines 39-41). The amount of rewinding within the current track is based on the duration the REVERSE button is depressed (*Eyer*, col. 7, lines 43-45).

Eyer also discloses SKIP BACKWARD button that used to play the previous audio track before the current track (*Eyer*, col. 7, lines 61-64). By holding down the SKIP BACKWARD button, tracks before the first previous track can be played (*Eyer*, col. 7, lines 64-65).

Eyer also discloses a FAST FORWARD button analogous to the REVERSE button but for moving forward within a track, and a SKIP FORWARD button analogous to the SKIP BACKWARD button for skipping to tracks subsequent to the current track (*Eyer*, col. 7 lines 50-59 and col. 8, lines 5-13).

The Examiner relies upon *Eyer's* REVERSE and FAST FORWARD buttons when addressing the claimed selection means, stating that "[t]he amount of fast forwarding or rewinding is a function of the duration in which the button is depressed" (Office Action at p. 3). However, even assuming the Examiner is correct, *Eyer* does not disclose that a user can select either a position within the current track or skip to a previous/subsequent track by depressing the REVERSE/FAST FORWARD buttons for a different duration of time. Instead, if *Eyer's* user wishes to access a separate track, *Eyer's* user uses the SKIP BACKWARD/SKIP FORWARD buttons instead of the REVERSE/FAST FORWARD buttons, as discussed.

Eyer's REVERSE button can be used to "reverse beyond the current track to previous tracks" (*Ever*, col. 7, lines 48-49). However, in doing so, the user does not "skip" the current track, the user simply reverses through the current track to the previous track. Therefore, *Eyer* fails to render obvious the claimed "wherein whether the selection means skips to the second content item or selects the position within the first content item depends on a duration of the user input."

As explained above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, no reason has been clearly articulated

as to why the claim would have been obvious to one of ordinary skill in view of *Hassell* and *Eyer*. Therefore, a *prima facie* case of obviousness has not been established for independent claim 1 for at least this reason. Although of different scope than claim 1, independent claim 51 is distinguishable from *Hassell* and *Eyer* for at least the same reasons as claim 1.

Claims 45 and 48-50 depend from claim 1, and claims 54 and 56-58 depend from claim 51. Because *Hassell* does not support the rejection of independent claims 1 and 51 under 35 U.S.C. § 103(a), *Hassell* also does not support the rejection of dependent claims 45, 48-50, 54, and 56-58.

II. The Rejection of Claims 44 and 52 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 44 and 52 under 35 U.S.C. § 103(a). Claim 44 depends from claim 43, and claim 52 depends from claim 51. As already discussed, *Hassell* and *Eyer* fails to render obvious the claimed selection means.

Durlach also does not render obvious the claimed “wherein whether the selection means skips to the second content item or selects the position within the first content item depends on a duration of the user input.”

Durlach discloses a “movie storage, traversal, annotation, and viewing method” where “[t]emporal progression through a movie frame sequence ... is determined at view time through ... [d]irect manipulation of user-controlled physical actuators ... such as dials” (*Durlach*, abstract). *Durlach* continues, “[w]hen dial 32 is turned relatively slowly, movie 200 will advance slowly forwards or backwards ... [u]p to approximately the

normal viewing speed, advance through movie 200 image frames will be approximately linear ... [a]bove approximately normal speed ... [the rate] becomes highly non-linear” (*Durlach*, col. 13, lines 1-18). However, *Durlach* does not disclose selecting a position within a content item, or skipping to another content item, depending on the duration of time a user works the dial. Therefore, *Durlach* fails to render obvious “wherein whether the selection means skips to the second content item or selects the position within the first content item depends on a duration of the user input,” as recited by independent claim 43.

As explained above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary skill in view of *Hassell Eyer*, and *Durlach*. Therefore, no *prima facie* case of obviousness has been established with respect to claims 44 and 52. Applicant therefore respectfully requests the Examiner to withdraw the rejection of these claims under 35 U.S.C. § 103(a).

III. The Rejection of Claims 45 and 53 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 45 and 53 under 35 U.S.C. § 103(a). Claim 45 depends from claim 43, and claim 53 depends from claim 51. As already discussed, *Hassell* and *Eyer* fail to render obvious the claimed selection means.

Maissel also does not render obvious a selection means “wherein whether the selection means skips to the second content item or selects the position within the first content item depends on a duration of the user input.”

Maissel discloses, “[i]n a digital television recording method, programs are selected for recording based on analysis of program schedule information, user preferences, and the priority of previously recorded programs” (*Maissel*, abstract). *Maissel* also discloses a “NEXT” button that can be used to browse forward through the stored programs (*Maissel*, ¶ 368). However, *Maissel* does not disclose selecting either a position within the current program, or skipping the next recorded program, based on the duration that the “NEXT” button is depressed. Therefore, *Maissel* does not render obvious “wherein whether the selection means skips to the second content item or selects the position within the first content item depends on a duration of the user input,” as recited by independent claim 1.

As explained above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary skill in view of *Hassell Eyer*, and *Maissel*. Therefore, no *prima facie* case of obviousness has been established with respect to claims 45 and 53. Applicant therefore respectfully requests the Examiner to withdraw the rejection of these claims under 35 U.S.C. § 103(a).

IV. The Rejection of claims 47 and 55 under 35 U.S.C. § 103(a)

Applicant respectfully traverses the rejection of claims 47 and 55 under 35 U.S.C. § 103(a). Claim 47 depends from claim 43, and claim 55 depends from claim 51. As already discussed, *Hassell* and *Eyer* fails to render obvious the claimed selection means.

Schein also does not render obvious a selection means “wherein whether the selection means skips to the second content item or selects the position within the first content item depends on a duration of the user input.”

Schein discloses a “television schedule system and method” using an “input device [that] allows the viewer to browse through the schedule information area” (*Schein*, abstract). *Schein* also discloses a “local controller” with a “horizontal scroll mechanism for moving the cursor in an ‘x’ direction or horizontally across the display screen ... buttons 32, 34 can be configured so that continuous depression of one button 32, 34 moves the cursor horizontally through a plurality of items” (*Schein*, col. 5, lines 45-59). However, even assuming *Schein*’s “items” correspond to the claimed first and second content items, *Schein* does not disclose selecting a position in a first content item, or skipping to a second content item, based on the duration that the user depresses the button 32 or 34. Therefore, *Schein* does not render obvious “wherein whether the selection means skips to the second content item or selects the position within the first content item depends on a duration of the user input,” as recited by independent claim 1.

As explained above, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the claimed invention and the prior art. Accordingly, no reason has been clearly articulated as to why the claim would have been obvious to one of ordinary skill in view of *Hassell Eyer*, and *Schein*. Therefore, no *prima facie* case of obviousness has been established

with respect to claims 47 and 55. Applicant therefore respectfully requests the Examiner to withdraw the rejection of these claims under 35 U.S.C. § 103(a).

V. Conclusion

In view of the foregoing, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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